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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,831	11/28/2001	Shinya Yoshida	0033-0770P	5530

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EXAMINER

AGUSTIN, PETER VINCENT

ART UNIT PAPER NUMBER

2652

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/937,831

Applicant(s)

YOSHIDA ET AL.

Examiner

Peter Vincent Agustin

Art Unit

2652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 8.

Claim(s) rejected: 1-3, 5-7 and 9-12.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

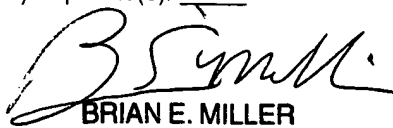
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s).

13. ☐ Other: _____.


BRIAN E. MILLER
PRIMARY EXAMINER

Continuation of 3. NOTE: The amendments to claim 1, i.e., passing reflected light "through" said first member, considerably changes the scope of the claim and raises new issues that would require further consideration of the applied references and/or further search. Furthermore, in regard to claim 7, the addition of "for tracking beam generation" would require further consideration of the applied references and/or further search.

Continuation of 11. does NOT place the application in condition for allowance because of the following reasons:

The Applicant's arguments filed April 12, 2005 have been fully considered but are not found to be persuasive.

The Applicant argues on page 7, last paragraph that "the Office Action's suggestion of adding the diffraction element 20 of Yoshida between the beam splitter and photodetector of Kobayashi would not result in more accurate reading of focus error. Applicants submit that instead the combination would result in a redundant function that would render Kobayashi's device unsuitable for carrying out its intended operation." Specifically, the Applicant states on page 8, first paragraph that "Kobayashi's diffraction elements 112c/112d already provide the diffraction function necessary for proper operation of its device. Inserting the diffraction grating of Yoshida in the path of differential beams from 112c/112d would only result in altering the diffraction pattern of Kobayashi's device in a manner that may render it unsuitable for carrying out its intended operation. Because Kobayashi's device already contains a diffraction element 112c/112d, Applicants submit that it would not have been obvious to one of ordinary skill to insert another diffraction grating between that existing diffraction grating and the photodetector. Rather than obtaining a more accurate focus error signal as alluded to in the Office Action, the combination would render the device of Kobayashi unsuitable for carrying out its intended operation." In addition, the Applicant argues on page 8, last paragraph that "one of ordinary skill in the art would not have considered inserting the diffraction grating 20 of Yoshida in the path between birefringent crystal plate 113 and photodetectors 118/ 119 of Kobayashi, because such a combination would also result in redundant components...". In addition, the Applicant argues on page 9, first paragraph that "combining Yoshida's diffraction element 20 with Kobayashi's arrangement would change the principle of operation of Kobayashi's system" and "Adding a diffraction element to the arrangement of Kobayashi would result in an unusual diffraction pattern and render it unable to implement the knife-edge method." For these reasons, the rejection of claim 1 allegedly fails to establish prima facie obviousness.

The Examiner disagrees. In the Office Action mailed January 12, 2005, it is the Examiner's position (see last paragraph of page 3 and first paragraph of page 4) that

"Kobayashi does not disclose a first diffraction element arranged on an optical path extending from said beam splitter to said photodetector, said first diffraction element receives said light reflected from said magneto-optical recording medium past said first member and said second member, said first diffraction element is divided in two by a line parallel to a plane orthogonal to said first and second parallel planes of said beam splitter, to have first and second regions; and light reflected by said magneto-optical recording medium that is diffracted by said first region is directed to said boundary of said photo detection portions"

Therefore, in the Office Action mailed January 12, 2005, these features were regarded as "missing" from the Kobayashi et al. reference. The Yoshida et al. reference was relied upon to provide these missing features. Page 4, paragraph 2 of said Office Action indicates that "It would have been obvious to one of ordinary skill in the art at the time of invention by the applicant to have added the diffraction element of Yoshida between the beam splitter and photodetector of Kobayashi, the motivation being to obtain a more accurate reading of a focus error signal, thereby minimizing recording/reproducing errors...and ensuring recording/reproduction accuracy." In other words, it would have been obvious to have added the diffraction element between the beam splitter and photodetector, under the Examiner's assumption that these features were in fact missing. Therefore, the Applicant's statement that it would not have been obvious to insert "another" diffraction grating between that "existing" diffraction grating and the photodetector is not valid. For the same reasons, the Applicant's statement that this combination of references would result in a "redundant" function that would render Kobayashi's device unsuitable for carrying out its intended operation is also not valid. Therefore, the rejection is maintained.

The Applicant argues on page 9, paragraph 2 that "the combination of Yoshida and Kobayashi is based on impermissible hindsight". Specifically, the Applicant points out that "Neither Yoshida nor Kobayashi teach or suggest the position of the diffraction element with respect to the beam splitter". This statement is inconsistent with the Applicant's admission that "Kobayashi's diffraction elements 112c/112d already provide the diffraction function necessary for proper operation of its device." (page 8, lines 1-2), which admission clearly suggests that the Kobayashi reference teaches the position of the diffraction element with respect to the beam splitter. Therefore, this argument is not valid. For the same reasons, the Applicant's statement that "The only information indicating that a diffraction element would be located between the beam splitter and photodetector comes from applicants' own disclosure. In other words, without applicants' own disclosure, there is no evidence as to the position that the diffraction element of Yoshida would be placed with respect to a beam splitter." (page 9, paragraph 4) is not persuasive. Therefore, the rejection is maintained.

The Applicant argues on the last five lines of page 11 that the rejection of claim 7 fails to establish a prima facie obviousness because the Hayashi reference fails to make up for the deficiency of Kobayashi, Yoshida and Ando because the Hayashi reference teaches the same use of a hologram as Kobayashi. This argument is not found to be persuasive for the same reasons noted above regarding the Kobayashi reference. Therefore, the rejection is maintained.

The Applicant notes on page 6, paragraph 3 that "the title had been replaced with a new title "OPTICAL PICKUP DEVICE FOR MAGNETO-OPTICAL DISK"". In spite of this change, the Examiner maintains that this title is still not descriptive of the invention to which the claims are directed (see item 2 of said Office Action).